



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/069,052

02/21/2002

John Scott Strachan

12395.00

9306

7590

04/28/2004

Frederick S Frei
Dorsey & Whitney
1001 Pennsylvania Avenue NW
Suite 300 South
Washington, DC 20004

EXAMINER

SHAY, DAVID M

ART UNIT

PAPER NUMBER

3739

DATE MAILED: 04/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/009,052

Applicant(s)

Strachan

Examiner

d. shg

Group Art Unit

3779

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on January 15, 2003
- ☒ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-10 + 12-14 is/are pending in the application.
Of the above claim(s) _____ is/are withdrawn from consideration.
- ☒ Claim(s) 1-10, 12, + 13 is/are allowed.
- ☒ Claim(s) 14 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____
 - ☒ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 14 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no disclosure as to the construction, structure, or configuration required to “produce for each pulse an isolated traverse through the frequency mode of the laser”.

Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Exactly what structure is to be inferred by reciting that “said pulse laser produces short duration pulses to produce for each pulse an isolated traverse through the frequency mode of the laser” is unclear.

Applicant’s argument that the problematic phrase exists in the specification is not convincing. If the mere presence of the phrase were sufficient to bring to light the meaning of or structure inferred by the phrase, then the presence thereof in the claim would have been sufficient to obviate the rejection. Further, applicant’s arguments that ‘one skilled in the art would readily recognize that the production of an “isolated traverse through the frequency mode of the laser” is inherent in the operation of the claimed apparatus’ not convincing since the meaning of the phrase itself is unclear. As is well known in the art LASER is an acronym meaning Light Amplification by Stimulated Emission Radiation, and this amplification arises

from a resonant cavity. The resonance of a laser cavity is tuned to a particular wavelength, each wavelength of light being associated with a single frequency thereof. Thus it is unclear how the single frequency emission of the laser would be "traversed through" or how such traversal would be "isolated" nor exactly what the "frequency mode" of the laser would be, since if no frequency is produced, there is no laser light emitted. Is the reference to the "frequency mode" merely a cumbersome expression to indicate that the laser is turned on? The use of the term in the specification would appear to indicate that it is more than this, but exactly what it is remains unclear. Lastly, if the performance of this traversal is inherent, then claim 14 is also not further limiting as it merely described a feature already inherent in the device. Thus claim 14 is also rejected under the fourth paragraph of section 112, in view of applicant's arguments.

Claims 1-10, 12 and 13 are allowed.

Applicant's arguments filed January 15, 2004 have been fully considered but they are not persuasive. The arguments are not persuasive for the reasons set forth above.

Applicant's arguments with respect to claim 14 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

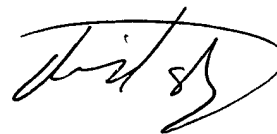
Art Unit: 3739

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to David Shay at telephone number 308-2215.

Shay/DL

April 8, 2004

A handwritten signature in black ink, appearing to read 'David M. Shay', enclosed within a large, loopy oval stroke.

**DAVID M. SHAY
PRIMARY EXAMINER
GROUP 330**